

REMARKS

Claims 3 and 7 have been revised to use alternative language to encompass the intended subject matter. No narrowing of claim scope is intended or believed to have occurred.

Claims 8, 10-12, and 17-19 have been canceled without prejudice for re-presentation of the subject matter of these claims in a continuing application.

Claims 15 and 16 have been revised to address a clerical error.

No new matter has introduced, and entry of the above revised claims is respectfully requested.

Formal Matters

Applicants respectfully request the Examiner's assistance in correcting the "Image File Wrapper" (IFW) for the instant application at the U.S. Patent and Trademark Office PAIR website.

Specifically, the non-final Office Action mailed May 9, 2007 is incorrectly indicated as a "Final Office Action" in the IFW. The corresponding "Application Data" and "Transaction History" portions of the website correctly identify the Action as "Non Final".

Claim Objections

Claims 3, 7, 15 and 16 were objected to for minor informalities. Applicants thank the Examiner for the helpful suggestions included with the statement of the objection. The above revisions to these claims are believed to address the informalities, and this objection may be properly withdrawn.

Rejection Under 35 USC § 102(b) Over Kim *et al.* (2002)

Claims 1-3, 5, 8-10, 12-14 and 18-20 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kim *et al.* (Abstract P21-31, 9th International Symposium on the Genetics of Industrial Microorganisms, 2002). Applicant have carefully reviewed the statement of the instant rejection and respectfully traverse because no *prima facie* case of anticipation is present. Reconsideration and withdrawal thereof are respectfully requested.

As an initial matter, Applicants point out that claims 8, 10-12, and 17-19 have been canceled as presented above. So the rejection of these claims has been obviated.

Turning to the instant rejection, it is established U.S. patent law that “in order to anticipate, a prior art disclosure must also be enabling, such that one of ordinary skill in the art could practice the invention without undue experimentation”. See SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331, 1337 (Fed. Cir. 2005).

However, Kim *et al.* do not enable the claimed subject matter at all. Kim *et al.* fail to disclose any procedure for preparing the phytase. To the contrary, Kim *et al.* only reports limited physico-biochemical properties of the reported phytase. Thus, the skilled person in the relevant field must engage in undue experimentation to enable the claimed subject matter based on the disclosure of Kim *et al.*

Additionally, Applicants point out that it is well settled that there must be *identity* between the teachings of an asserted document and the claimed subject matter (see for example MPEP 2131 and the case decisions cited therein). But while instant claim 1 encompasses a polypeptide comprising amino acid residues 23-433 of SEQ ID NO: 7, it is uncertain whether the activity reported by Kim *et al.* is the result of a polypeptide with a sequence related to SEQ ID NO:7. Because it is possible that Kim *et al.* reports phytase activity of a sequence distinct from SEQ ID NO:7. For example, the skilled person is aware that there are many cases of different polypeptides with the same physico-biochemical properties, such in cases of isozymes (allozymes) or isoforms of the same enzyme.

Moreover, and assuming only for the sake of argument that the Kim *et al.* activity has some relation to instant SEQ ID NO:7, it is unclear whether it results from a polypeptide containing all of SEQ ID NO:7, only residues 23-433, or some shorter fragment of SEQ ID NO:7.

Given the above explained ambiguities, the instant rejection improperly relies upon speculation to allege identity between the content of Kim *et al.* and the claimed subject matter. Such speculation does not meet the requirements of a *prima facie* case of anticipation, and so it is improper to assert a shift in burden to Applicants “to show a novel or unobvious difference between the claimed product and the product of [Kim *et al.*]”

For the above reasons, novelty of the present invention should be acknowledged by withdrawal of the instant rejection.

Allowable Subject Matter

Claims 6, 7, 11, 15, and 16 have not been rejected over the cited Kim et al. (2002) document. Therefore, Applicants believe these claims to contain allowable subject matter, and request confirmation of the allowability of these claims in the next Office Action.

Conclusion

It is believed that the application is now in condition for allowance. Applicants request the Examiner to issue a notice of Allowance in due course. The Examiner is encouraged to contact the undersigned to further the prosecution of the present invention.

The Commissioner is authorized to charge JHK Law's Deposit Account No. **502486** for any fees required under 37 CFR § 1.16 and 1.17 and to credit any overpayment to said Deposit Account No. **502486**.

Respectfully submitted,

JHK Law

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By: /Joseph Hyosuk Kim/
Joseph Hyosuk Kim, Ph.D.
Reg. No. 41,425

P.O. Box 1078
La Canada, CA 91012-1078
(818) 249-8177 - direct
(818) 249-8277 - fax